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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,957	02/26/2002	Jeffrey H. Nycz	DEP610	5011
27777	7590	12/29/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 10/082,957	Applicant(s) NYCZ ET AL.	
	Examiner Anu Ramana	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-23, 25-26, 28, 30, 32-33, 35, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Williamson et al. (US 5,925,077).

Regarding claims 21-23, 25-26, 28, 30, 32-33, 35, 37 and 38, Williamson et al. disclose an acetabular prosthesis or cup 10 having a convex surface 22 and a concave surface 20 with integral portions, each integral portion 86 being defined by a planar first surface spaced inwardly from the convex surface 22 and a planar surface spaced inwardly from the concave surface 20 (col. 1, lines 7-12, col. 4, lines 10-37, col. 5, lines 43-67 and col. 6, lines 1-12, Figures 3, 10 and 14I).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,370,702).

Regarding claims 21-40, Jones discloses an implant or prosthesis or cup 10 having a convex surface 20 and a concave surface 18. Recesses or "portions" 14 are provided spaced from the convex and concave surfaces; each recess having sidewalls 21, 22a with a removable portion 32, 32a about 0.005 to 0.5 inches thick; the removable

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portion 32, 32a having a first surface spaced inwardly from the convex surface 20 and a second surface spaced inwardly from the concave surface 18 with grooves 24 extending inwardly from the second surface to the first surface. Jones further discloses that punching may be applied to remove portion 32, 32a to form a hole in cup 10; the hole being used to fasten cup 10 by a bone screw or other fastener (col. 1, lines 8-24; col. 2, lines 14-38 and line 68; col. 3, lines 1-3, lines 13-23 and lines 37-49 and lines 57-64; col. 4, lines 8-47; Figures 1 and 5).

Jones discloses the claimed invention except that the first and second surfaces of the removable portion are "substantially planar." It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to the removable portion with a "substantially planar surface", since applicant has not disclosed that a "substantially planar surface" solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a removable portion in an acetabular cup. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

Regarding claims 23, 30 and 38, Jones discloses that recesses 14, 14a can have any shape depending on the configuration of the fastener that is used (col. 3, lines 44-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided cylindrical walls to the recesses 14, 14a, in order to place a cylindrical fastener.

Regarding claims 25 and 32, Jones discloses that acetabular cups typically include a liner into which the femoral head fits (col. 1, lines 13-23). It is well known that a femoral head is supported by and operably connected to a stem.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a stem, a femoral head operably connected thereto and a liner positioned between the acetabular cup and the femoral head for replacement of the hip socket.

Regarding claim 36, Jones clearly discloses that any suitable tool can be used to remove portion 14 by applying a punching force (col. 4, lines 9-19). Hand-held surgical

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tools capable of applying a punching force are well known in the art (as evidenced by Frank et al. (US 6,436,122). Accordingly, the method steps of claim 36 are performed during normal use of the prosthesis or cup 10 of Jones for the purpose of replacement of the acetabulum or hip socket due to bone disease or severe fracture (col. 1, lines 13-15).

Claims 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al. in view of Jones (US 5,370,702).

Williamson et al. do not disclose that ledge 86 has a thickness of 0.10 inches or less.

Jones teaches a removable portion having a thickness of 0.005 inches for ease of removal (col. 3, lines 50-64).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the a ledge 86 in the Williamson et al. prosthesis, as taught by Jones, for ease of removal of ledge 86.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al. in view of Frank et al. (US 6,436,122).

See previous discussion of the Williamson et al. reference for claims 21, 28 and 37.

Williamson et al. disclose all elements of the claimed invention except for a portable hand punch as the instrument for removing portion 86 (col. 5, lines 63-67 and col. 6, lines 1-12).

Frank et al. disclose a medical instrument such as a hand-held or "portable" punching tool used during a surgical operation.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the Frank et al. instrument to remove portion 86 of the Williamson et al. cup 10 by applying a pushing or "punching" force since it was known in the art to utilize an instrument such as the one disclosed by Frank et al. for applying a pushing or punching force.

The method steps of claim 36 are performed during normal use of the Williamson et al. device in combination with an instrument of the type disclosed by Frank et al.

Response to Arguments

Applicant's arguments filed under "REMARKS" in the response filed on September 28, 2004 have been fully considered but they are not persuasive for the following reasons.

Applicants' amendments to claims 21-23, 25-26, 28, 30, 32-33, 35 do not overcome the rejection of the stated claims as being anticipated by Williamson et al. (US 5,925,077). Portions 86 of the Williamson et al. cup 10 are integral with cup 10 in that they are "formed as a unit" with cup 10. Williamson et al. also disclose that plug or "portion" 86 can be removed by "knocking the plug 86" off with an instrument or "portable hand tool" (see col. 5, lines 63-67). Further, the limitation "to permit the portion of said cup.....opening therethrough" does not patentably distinguish over the Williamson et al. reference because portion 86 is capable of being removed by any suitable instrument.

Applicants' amendments to claims 21-40 do not overcome the rejection of the stated claims as being unpatentable over Jones (US 5,370,702). Jones clearly discloses that removable portion 14 in cup 10 can be removed by configuring portion 14 such that a force such as punching may be applied to remove base 26 or removable portion 14 (see col. 3, lines 65-68 and col. 4, lines 1-18). Further, the limitation "to permit the portion of said cup.....opening therethrough" does not patentably distinguish over the Jones et al. reference because portion 14 is capable of being removed by any known punching tool. The art is replete with portable hand-held punching tools (see cited art).

Regarding the combination of Williamson et al. and Jones, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

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some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jones clearly teaches that the removable portion can be configured or constructed so that it can be removed by pushing, punching or twisting (underlining for emphasis) (see col. 4, lines 16-19). Jones further provides an exemplary thickness of 0.005 inches for ease of removal of the removable portion.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached at Monday through Friday between 8:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Annette Ramana*
December 25, 2004

Cary E. O'Connor
Cary E. O'Connor
Primary Examiner